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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,061	03/12/2004	Eitan Cadouri	524322001200	6747
56702	7590	03/28/2006	EXAMINER	
PDF SOLUTIONS c/o MOFO SF 425 MARKET STREET SAN FRANCISCO, CA 94105			HOLLINGTON, JERMELE M	
			ART UNIT	PAPER NUMBER
			2829	

DATE MAILED: 03/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H/A

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/799,061

Applicant(s)

CADOURI, EITAN

Examiner

Jermele M. Hollington

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

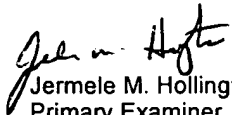
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): rejection under 35 USC 112.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-16.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


Jermele M. Hollington
Primary Examiner
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DETAILED ACTION

Advisory Action

1. Applicant's arguments filed March 9, 2006 have been fully considered but they are not persuasive (except for the argument regarding claim rejections under 35 USC 112).

Regarding the claim objections of claims 1-2, the applicants argue: *"...As set forth in MPEP 2111.02(II), preamble recitations can be mere statements of purpose or use. Applicant asserts that the statement "selecting a die placement" in the preamble of claim 1 is clearly a statement of purpose. Steps a) to d) recite the steps to achieve the stated purpose of selecting a die placement. Thus it is logical to start the process of selecting a die placement by obtaining a die placement, which is not necessarily the die placement that will ultimately be selected by performing steps b) to d). The Examiner also states, "the examiner is maintaining the claim objection as well as the position that there is only one die placement in the claims." Applicant asserts that this position is illogical in view of step d) in claim 1. In particular, step d) requires that there be at least two die placements (i.e., the die placement before it was adjusted and the die placement after it is adjusted)."*

In response to the above argument, the same section of the MPEP stated above also states: *"...the court held that the preamble is not merely a statement of effect that may or may not be desired or appreciated, but rather is a statement of the intentional purpose for which the method must be performed."* See *Jansen v. Rexall Sundown, Inc.*, 342 F.3d 1329, 1333-34, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003). Based on the last lines of the argument, *"In particular, step d) requires that there be at least two die placements..."* the examiner is valid in the responds in the office action mailed on Jan. 9, 2006, which was also stated in the first paragraph of the applicants argument: *"if the die placements are different, the Examiner will like to suggest to applicant to change the claim language to show they are different."* Therefore, the examiner will maintain the claim objections to claims 1 and 2.

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B) Regarding claim rejections under 35 USC 103, the applicants argue: "Independent claims 1, 8, and 14 recite that the "die placement defines the locations on the wafer on which the dies are to be fabricated." In contrast, the Johnson reference relates to placement and bonding of a die on a substrate after the die has been diced or cut from the wafer on which it was formed. Thus, the "die placement" recited in claims 1, 8 and 14 is non-analogous to the placement of dies referred to in the Johnson reference... the placement of dies referred to in the Johnson reference are of dies after they have been cut from the wafer. In contrast, the testing referred to in paragraph [0004] of the present specification...refers specifically to testing the dies while the dies are still on the wafer... Thus, the testing described in paragraph [0004] is incompatible with the testing disclosed in the Johnson reference because paragraph [0004] describes testing dies that are still on the wafer while the Johnson reference discloses testing dies after they have been cut from the wafer."

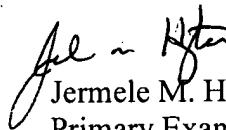
In response to the above argument, after reviewing the Johnson reference, the examiner is unable to locate where it states or even suggest that the testing are done after the dies have been cut. The applicant has not provided persuasive evidence to the argument. The examiner believes that the Johnson reference does test while the dies are on the wafer. Therefore the examiner believes that the prior arts still read on the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermele M. Hollington whose telephone number is (571) 272-1960. The examiner can normally be reached on M-F (9:00-4:30 EST) First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (517) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jermele M. Hollington
Primary Examiner
Art Unit 2829

JMH
March 23, 2006